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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/560,068	06/05/2006	Sophie Creux	26217	9849

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OWENS CORNING
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EXAMINER	
COLE, ELIZABETH M	
ART UNIT	PAPER NUMBER
1794	

NOTIFICATION DATE	DELIVERY MODE
11/05/2009	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

USIPDEPT@owenscorning.com

Office Action Summary	Application No.	Applicant(s)	
	10/560,068	CREUX ET AL.	
	Examiner	Art Unit	
	Elizabeth M. Cole	1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *27 July 2009*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-6 and 8-20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-6 and 8-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *9/10/09*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

1. Claims 1-6, 8-13 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification as originally filed does not provide support for the limitation that the composition is "contains no lithium oxide other than trace impurities". The specification at page 3 states that the composition contains no lithium oxide but that is not the same as "no lithium oxide other than trace impurities".

2. Claims 1-6,8-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

3. It is not clear what is meant by "trace impurities", because it is not clear what values this encompasses.

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-6, 8-20 are rejected under 35 U.S.C. 102(a) and (e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Lewis, U.S. Patent application Publication 2004/0092379. Lewis discloses a glass composition for forming into glass fibers comprising SiO_2 in amounts of 49-76 wt percent; Al_2O_3 in amounts of 2-23 weight percent; CaO in amounts of 3-15 weight percent and MgO in amounts of 2-15 weight percent. See paragraph 0042t. The composition can be used to make glass fibers. The amounts anticipate the claimed amounts. The amounts of B_2O_3, TiO_2, $Na_2O + K_20$, F_2 and Fe_2O_3 are below the maximum values set forth in the claims. See paragraph 0042. Lewis teaches amounts of lithium oxide of 0-9 percent. See paragraph 0042. Since Lewis teaches amounts which encompass the claimed ranges, Lewis also teaches the ranges and ratios set forth in claims 4-6,9-13. Lewis does not disclose the T liquid temperatures, the claimed Young's Modulus, or T log=4. However, since Lewis discloses a glass composition and yarn having the same components present in the same amounts, it is reasonable to expect that the material of Lewis would possess the claimed properties. Where applicant claims a composition in terms of a function, property or characteristic and the composition of the prior art is the same as that of the claim but the function is not explicitly disclosed by the reference, the examiner may make a rejection under both 35 U.S.C. 102 and 103, expressed as a 102/103 rejection.

"There is nothing inconsistent in concurrent rejections for obviousness under 35 U.S.C. 103 and for anticipation under 35 U.S.C. 102." In re Best, 562 F.2d 1252, 1255 n.4, 195 USPQ 430, 433 n.4 (CCPA1977).

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 1-6 and 8-20 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-6, 12-15 of copending Application No. 11/722,039. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims a composition having the overlapping ranges of the same constituents which is useful for making glass fibers and yarns. Although the claims of US '039 include lithium oxide, it is present in amounts of 0.1-0.8 which indicates that the material is substantially free of lithium.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

8. Applicant's arguments filed 7/27/099 have been fully considered but they are not persuasive.

9. With regard to the 112 rejections, Applicant argues that the specification teaches that trace impurities may be present in the composition. However, the specification does not discuss what trace impurities would be present or the amounts in which they would be present. The specification does not discuss lithium oxide in the context of trace impurities. Therefore, the rejections are maintained because there is not adequate disclosure of the claimed invention in the specification and because the scope of the claims is indefinite, in that it is not clear what values of lithium oxide would be considered acceptable as a trace impurity and what values would be too much. If applicant can show that these terms were accepted in the art as having particular and definite meaning in terms of amount tolerated and viewed as a trace impurity, and that one of skill in the art would expect that the trace impurities generally discussed in the specification would include lithium oxide in a particular amount, these rejections could be overcome.

10. Applicant argues that Lewis does not anticipate or render obvious the claimed invention because Lewis does not teach a composition having no lithium oxide other than trace impurities. However, Lewis teaches a range of lithium oxide in the glass composition of 0-9%. Since Lewis teaches that the amount of lithium oxide can be 0, it teaches no lithium oxide being present. Applicant argues that some of the claims of Lewis have a positive amount of lithium oxide. However, it is noted that the disclosure of Lewis is broader than what is claimed. Lewis clearly and unequivocally teaches

compositions wherein the amount of lithium oxide is zero. Thus, Lewis anticipates the limitation that the composition contains no lithium oxide other than a trace impurity because Lewis discloses a range of lithium oxide values which explicitly includes zero weight percent, i.e., no lithium oxide at all. Further, examples 1-7, 8-9, 11-12 do not include lithium oxide and paragraph 0038 and 0042 teach lithium oxide as being an optional component. Further, most of the claims do not recite lithium oxide being present at all, including the independent claims.

11. Applicant argues that Lewis does not teach the claimed Young's Modulus. However, since Lewis does teach a glass composition for making glass fibers wherein the composition anticipates the claimed composition, it is reasonable to expect that the fibers of Lewis would have the same properties as the instantly claimed fibers. The same materials cannot have different properties. There is a reasonable basis for expecting the fibers of Lewis to have the same properties as the claimed fibers due to their same composition. The burden is thus shifted to applicant to show that the fibers of Lewis do not have the claimed properties such as Young's Modulus.

12. Applicant argues that US '039 is not a valid reference against the instant application. However, as previously noted, the copending US application is not applied as a prior art reference but in an obviousness type double patenting rejection, which does not require the copending application be available as a prior art reference. Therefore, the rejection is maintained.

13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elizabeth M. Cole whose telephone number is (571) 272-1475. The examiner may be reached between 6:30 AM and 6:00 PM Monday through Wednesday, and 6:30 AM and 2 PM on Thursday.

The examiner's supervisor Rena Dye may be reached at (571) 272-3186.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

The fax number for all official faxes is (571) 273-8300.

/Elizabeth M. Cole/
Primary Examiner, Art Unit 1794

e.m.c